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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/638,078	08/14/2000	Fernando Jose Barros Rodrigues da Silva	13137	1036

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05/05/2003

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EXAMINER

GUBIOTTI, MATTHEW P

ART UNIT

PAPER NUMBER

2124

DATE MAILED: 05/05/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.:

09/638,078

Applicant(s)

RODRIGUES DA SILVA,
FERNANDO JOSE BARRO

Examiner

Matthew Gubiotti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 August 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. The drawings are objected to because the relevant elements are not numbered or labeled. The absence of specific numbering creates confusion in correlating the detailed description of the invention in the specification to the appropriate element(s) in the figures. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-26 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per claims 1-26, merely claimed as a computer implementation representing a computer listing *per se*, that is, descriptions or expressions of such a program and that is, descriptive material *per se*, non-functional descriptive material, and is not statutory because it is not a physical

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"thing" nor a statutory process, as there are not "acts" being performed. Such claimed computer implementations do not define any structural and functional interrelationships between the computer program and other claimed aspects of the invention which permit the computer implementation's functionality to be realized. The invention is an abstract conception and, as described, exists merely as a notion of a set of instructions capable of being executed by a computer. The implementation itself is not a process, without the computer-readable medium needed to realize the computer program's functionality. In contrast, a claimed computer-readable medium encoded with a computer program defines structural and functional interrelationships between the computer program and the medium which permit the computer program's functionality to be realized, and is thus statutory. **Warmerdam**, 33 F.3d at 1361, 31 USPQ2d at 1760. **In re Sarkar**, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978). See MPEP § 2106(IV) (B) (1) (a).

Further, the claimed invention as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." **State Street**, 149 F.3d at 1373, 47 USPQ2d at 1601-02. As described, the programming implementation does not recite an express purpose to clearly indicate the utility of the claimed invention. The purpose of

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this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (Brenner v. Manson, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96); In re Ziegler, 992, F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)). See MPEP § 2106.

To overcome this rejection, it is suggested that the Applicant clearly and distinctly cite a concrete application for purposed invention. The Examiner suggests claim language such as "A [programming implementation which] computer-executable program stored as computer executable instructions on one or more computer-readable media, the program provides support...".

This would included a detailed account of how the claimed elements are to be combined within a computing system to achieve a level of utility. The relationship between the claimed elements much be such that the subject matter to which the invention relates is expressly clear.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-26 are rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either an asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 10 and 11 are sufficiently uncertain in their language as to render them indefinite. The use of the word "may" (See e.g., p.39, li.5) creates a level of indefiniteness that destroys any desired limitation. The model presented may or may not describe the reusable software unit.

Claim Rejections - 35 USC § 102

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8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that would form the basis for the rejections under this section, should the Applicant amend the claims to overcome the above rejections that render the claims non-statutory:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Gosling ("The Java™ Language Environment, A White Paper", May 1996, Sun Microsystems, Inc., pp.1-85).

Claim 1

Gosling teaches a programming implementation substantially as disclosed, comprising a repository of reusable software units (p.67, § 9.1), each of which are arranged to behave independently ("encapsulation", p.26, § 3.1), communicate transparently ("public instance variables"; p.31, li.43-47), and facilitate creation of new reusable software units (p.29-30, §§ 3.3.2 and 3.3.3).

Claim 2

Gosling further teaches wherein the reusable software units are arranged to display a scalable mechanism to thoroughly

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isolate each unit from its peers ("private level access control"; p.36, § 3.3.8).

Claim 3

Gosling further teaches arranging the software units to facilitate reuse of a software system design constructed with reusable software units (p.33, ¶ 2).

Claim 4

Gosling further teaches arranging the software units to communicate to the outside world only through input and/or output gates (p.30-31, § 3.3.4; See also Specification, p.8, li.14-16) (referencing messaging between private objects done only through accessor method, as illustrated by figure 3.3.4.1).

Claim 5

Gosling further teaches arranging the software units to include a variable mechanism that abstracts all outside software units and whose meaning can only be known at run-time ("abstract methods"; p.37, § 3.3.11).

Claim 6

Gosling further teaches arranging the software units in an interconnection of channels ("package"; p.36, § 3.3.9) (See e.g p.67, Fig. 9.1.1).

Claim 7

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Gosling further teaches wherein the reusable software units do not include absolute addresses of other software units not belonging to its state ("dynamic binding", p.26, § 3.1; P.46, § 5.1.2, ¶ 1).

Claim 8

Gosling further teaches wherein the reusable software units are unaware of the methods of other software units not belong to its state ("private level access control"; p.36, § 3.3.8).

Claim 9

Gosling further teaches wherein said reusable software units are dynamically configurable ("polymorphism"; p.26, § 3.1).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew Gubiotti whose telephone number is (703) 305-8285. The examiner can normally be reached on M-F, 8-4PM.

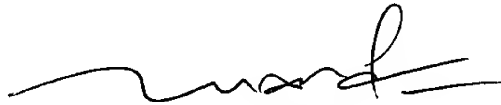
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (703) 305-9662. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

MPG

April 30, 2003



TUAN Q. DAM
PRIMARY EXAMINER